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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,095	02/11/2004	Craig D. Johnson	68.0230CNT1	2344
35204	7590	04/12/2006	EXAMINER	
SCHLUMBERGER RESERVOIR COMPLETIONS			THOMPSON, KENNETH L	
14910 AIRLINE ROAD			ART UNIT	
ROSHARON, TX 77583			PAPER NUMBER	

3672

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/776,095

Applicant(s)

JOHNSON ET AL.

Examiner

Kenneth Thompson

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29,31-36,43-49,51-58 and 74-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-58 and 74-79 is/are allowed.
- 6) ☒ Claim(s) 29,31-36,43-49 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/05/6/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29, 31-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-33 of U.S. Patent No. 6,695,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application limitations although broader are obviously met by the patent which discloses a expandable tubular with a locking means, and a base pipe, shroud and a plurality of overlapping filter sheets as recited in the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3672

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Lowe, U.S. 2,677,466.

Regarding claims 29 and 31, Lowe discloses in figure 1 an expandable tubular system (col. 2, lines 48-51) having a tubular member (20,21) with openings (14), a first layer (29) and a second layer (23) covering the tubular member, and a locking mechanism (15,16;11) resisting collapse (col. 3, lines 10-20) located radially within the layers.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 43-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Lohbeck 5,366,012.

Lohbeck discloses (fig 2) delivering a sand screen to a wellbore region having a non uniform diameter formed by a cased section and an openhole section, applying an expansion force to the sand screen in a radially outward direction and expanding the sand screen to substantially eliminate any annulus between the sand screen and the wellbore region having the non uniform diameter (col. 4, lines 34-40).

Referring to claim 44, Lohbeck discloses expanding comprises creating contact between the sand screen and a wall defining the wellbore region (col. 4, lines 34-40).

Referring to claim 45, Lohbeck discloses expanding comprises applying an outwardly directed force (by element 15) against the wall with the sand screen.

Referring to claim 46, Lohbeck discloses wherein expanding comprises expanding the sand screen (11) into the wellbore region having two dissimilar diameters.

Referring to claim 47, Lohbeck discloses applying comprises moving an expansion tool (15) through an interior of the sand screen.

Claims 48, 49 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Gano 6,478,091.

Referring to claims 48, 49, Gano discloses a sand screen (fig. 1a and 1b) in an uncased borehole having a plurality of expandable filter sections (14,16,18) and a plurality of seal sections (28,30,32,34) comprising an elastomeric material wherein the plurality of expandable filter section are longitudinally separated by the at least one seal section and eliminate the annulus (col. 3, lines 53-56).

Referring to claim 51, Gano discloses the seal section (28,30,32,34) has an expansion ratio at least as great as the expansion ratio of the plurality of expandable filter sections (28,30,32,34).

Claims 48, 49 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Coronado et al. 6,725,934.

Referring to claims 48-49, Coronado discloses a sand screen (figs. 1-3) in an uncased borehole having a plurality of expandable filter sections (28,20) and a plurality of seal sections

(26,24) comprising an elastomeric material wherein the plurality of expandable filter section are longitudinally separated by the at least one seal section and eliminate the annulus (fig 4 and 5).

Referring to claim 51, Coronado discloses the seal section (24,26) has an expansion ratio at least as great as the expansion ratio of the plurality of expandable filter sections (20,28).

### ***Allowable Subject Matter***

Claims 52-58 and 74-79 are allowed.

### ***Response to Arguments***

Applicant's arguments filed 23 January 2006 with respect to the prior art of Lohbeck, Gano and has been fully considered but they are not persuasive.

Applicant argues the prior art of Lohbeck expands the screen to a single permanent diameter and does not eliminate any annulus between it and the wellbore region. Applicants present similar arguments with respect to the prior art of Gano and Coronado.

The claim does not require elimination of the annulus nor all portions of the annulus. The prior art discloses the liner is compressed into the borehole, which eliminates all of the annulus.

Applicant's arguments filed 23 January 2006 with respect to claim 29 is moot in view of the new grounds of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

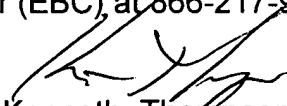
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Thompson whose telephone number is 571 272-7037. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10 April 2006



Kenneth Thompson  
Primary Examiner  
Art Unit 3672